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EXAMINER	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THEODORE JAMES MYERS,
PATRICK JAY WALSH,
MUNA NABILSI, and
KEVIN D. KASCHKE

Appeal 2009-014719
Application 09/391,427
Technology Center 3600

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL[1]

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Theodore James Myers et al. (Appellants) seek our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 12-15, 17-22, 24, 25, 38-43, 59-63, and 66-77. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE. [2]

THE INVENTION

This invention is a combination of a reservation and navigation system. Specification 1:10-12.

Claim 12, reproduced below, is illustrative of the subject matter on appeal.

> 12. A method, comprising:
>
> accessing reservation information representing a good or a service that may be reserved by customers from one of a plurality of businesses;
>
> making a request for a reservation of the good or the service responsive to the step of accessing the reservation information;
>
> receiving confirmation information, representing that the reservation has been made for the good or the service associated with one of the plurality of businesses, responsive to the step of

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[2] Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed Dec. 9, 2008) and Reply Brief ("Reply Br.," filed Jan. 16, 2009), and the Examiner's Answer ("Answer," mailed Dec. 24, 2008).

making the request; and

receiving electronic navigation information from a reservation communication device over a communication link responsive to the step of receiving the confirmation information, wherein the electronic navigation information comprises directions to assist the customer in traveling from a customer geographic location to a business geographic location of the good or the service reserved by the customer, wherein the customer geographic location is automatically determined for the customer by a location-determining device in response to receipt of the confirmation information.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Yoshida	US 5,877,704	Mar. 2, 1999
Zeitman	US 5,940,481	Aug. 17, 1999
DeLorme	US 5,948,040	Sep. 7, 1999
Sehr	US 6,085,976	Jul. 11, 2000

Appellants' Admitted Prior Art in the Background of Invention on pages 1-3 of the Specification. [Herein after, AAPA.]

The following rejections are before us for review:

1. Claims 12, 13, 18-21, 25, 38-43, 59-63, and 69-76 are rejected under 35 U.S.C. §103(a) as being unpatentable over Zeitman, AAPA, and DeLorme.
2. Claims 14, 17, and 24 are rejected under 35 U.S.C. §103(a) as being unpatentable over Zeitman, AAPA, DeLorme, and Yoshida.

3. Claims 15 and 22 are rejected under 35 U.S.C. §103(a) as being unpatentable over Zeitman, AAPA, DeLorme, and Sehr.
4. Claims 66-68 are rejected under 35 U.S.C. §103(a) as being unpatentable over Zeitman, AAPA, DeLorme, and Official Notice.

ISSUE

The issue is whether claims 12, 13, 18-21, 25, 38-43, 59-63, and 69-76 are unpatentable under 35 U.S.C. §103(a) over Zeitman and DeLorme. Specifically, the issue is whether DeLorme teaches "wherein the customer geographic location is automatically determined for the customer by a location-determining device in response to receipt of the confirmation information" (Claim 12). The rejection of claims 14, 17, and 24 under 35 U.S.C. §103(a) as being unpatentable over Zeitman, DeLorme, and Yoshida; of claims 15 and 22 under 35 U.S.C. §103(a) as being unpatentable over Zeitman, DeLorme, and Sehr; and of claims 66-68 under 35 U.S.C. §103(a) as being unpatentable over Zeitman, DeLorme, and AAPA also turn on this issue.

PRINCIPLES OF LAW

Obviousness

> Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.") The Court in *Graham* further noted that evidence of secondary considerations "might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented." *Graham*, 383 U.S. at 17-18.

"[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be come articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

ANALYSIS

The rejection of claims 12, 13, 18-21, 25, 38-43, 59-63, and 69-76 under 35 U.S.C. §103(a) as being unpatentable over Zeitman, AAPA, and DeLorme.

The Appellants argue that the combination of Zeitman, AAPA, and DeLorme does not teach "wherein the customer geographic location is automatically determined for the customer by a location-determining device *in response to receipt of the confirmation information*." App. Br. 5 and Reply Br. 2.

The Examiner argues that:

> DeLorme discloses a GPS system. The GPS system determines the customer location and

> assists in route planning. Examiner maintains that a GPS system utilized in the manner disclosed by DeLorme, i.e., "obtaining a printed map/ticket may then use TRIPS electronic output as downloaded into a PDA or GPS to guide the user during their travel" (DeLorme et al.; col. 10, lines 34-58), at a minimum suggests "automatically determining location information". Examiner further maintains that obtaining a map/ticket and then downloading the electronic output into the GPS to guide the user is the equivalent of "in response to receiving the confirmation information".

App. Br. 18.

The pertinent passage of column 10, lines 34-58 of DeLorme states: "A TRIPS user having made reservations and after obtaining a printed map/ticket may then use TRIPS electronic output as downloaded into a PDA or GPS to guide the user during their travel." Though not entirely clear, the Examiner seems to argue that because GPS systems are known to determine a location and to determine a route plan, that this passage teaches that the location is determine *in response to receiving the confirmation information* because the GPS guides the user *after* the map/ticket, which contains the confirmation information, is obtained.

However, we fail to see how this teaches that "the customer geographic location is automatically determined for the customer by a location-determining device *in response to receipt of the confirmation information."* A disclosure that a second event (i.e. downloading the electronic output into the GPS to guide the user) *may* occur *after* a first event (i.e. obtaining the printed map/ticket) does not teach that the second event occurs *in response* to the first event. We note that the Examiner provides no other explanation as to how one of ordinary skill in the art would have been

led by this passage to the customer geographic location being automatically determined for the customer by a location-determining *device in response to receipt of the confirmation information* other than asserting that it is an "equivalent." *See* Answer 6 and 18. We also note that the Examiner admits that Zeitman and AAPA do not disclose this limitation. Answer 6.

Independent claims 20 and 38 recites limitations similar to the limitation at issue above (*See* App. Br. 6), and our reasoning above applies equally to the rejection of those claims. Accordingly, we find that the Appellants have overcome the rejection of claims 12, 13, 18-21, 25, 38-43, 59-63, and 69-76 under 35 U.S.C. §103(a) as being unpatentable over Zeitman, AAPA, and DeLorme.

The rejection of claims 14, 17, and 24 under 35 U.S.C. §103(a) as being unpatentable over Zeitman, AAPA, DeLorme, and Yoshida.

This rejection is directed to claims dependent on claims 12 and 20, whose rejection we have reversed above. For the same reasons, we will not sustain the rejections of claims 14, 17, and 24 over the cited prior art. *Cf. In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) ("[D]ependent claims are nonobvious if the independent claims from which they depend are nonobvious."). We note that the Examiner did not combine Yoshida to cure the deficiency of the combination of Zeitman, AAPA, and DeLorme above. App. Br. 14.

The rejection of claims 15 and 22 under 35 U.S.C. §103(a) as being unpatentable over Zeitman, AAPA, DeLorme, and Sehr.

This rejection is directed to claims dependent on claims 12 and 20, whose rejection we have reversed above. For the same reasons, we will not sustain the rejections of claims 15 and 22 over the cited prior art. *Cf. In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) ("[D]ependent claims are nonobvious if the independent claims from which they depend are nonobvious."). We note that the Examiner did not cite Sehr to cure the deficiency of the combination of Zeitman, AAPA, and DeLorme above. App. Br. 15-16.

The rejection of claims 66-68 under 35 U.S.C. §103(a) as being unpatentable over Zeitman, AAPA, DeLorme, and Official Notice.

This rejection is directed to claims dependent on claim 12, whose rejection we have reversed above. For the same reasons, we will not sustain the rejections of claims 66-68 over the cited prior art. *Cf. In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) ("[D]ependent claims are nonobvious if the independent claims from which they depend are nonobvious."). We note that the Examiner did not cite AAPA to cure the deficiency of the combination of Zeitman, AAPA and DeLorme above. App. Br. 16.

DECISION

The decision of the Examiner to reject claims 12-15, 17-22, 24, 25, 38-43, 59-63, and 66-77 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

REVERSED

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